REMARKS

Applicant respectfully submits that the rejections are improper and should be withdrawn. First, it is respectfully submitted that the Chung reference does not yield the subject matter that the Examiner contends. Furthermore, a mere conjecture that one would combine the cited references because the disclosure of one reference would improve the disclosure of another cited reference does not constitute a proper motivation to combine as required by 35 U.S.C. § 103. In light of this, the Examiner's rejections are unsupported by the references (and knowledge held by one of ordinary skill in the art) and should be withdrawn. These points are discussed in detail below.

Claim Amendments

Before discussing in detail, the rejections based on prior art, however, Applicant notes that claim 1 has been amended to include the feature previously recited in claim 3, now cancelled. Thus, amended claim 1 has precisely the same scope as cancelled claim 3. Where required, the dependencies in other claims have been amended to be consistent with the amendment to claim 1 and concomitant cancellation of claim 3.

In addition, it is noted that claims 6 and 15 have been cancelled, and claims 10 and 12 have been amended to address the antecedent basis issues raised by the Examiner.

Chung Does Not Disclose What the Examiner Contends

Turning now to amended claim 1 (i.e., claim 3, as the application was filed), the Examiner contends that Chung anticipates the subject matter of amended claim 1. In order for Chung to anticipate amended claim 1, Chung necessarily must disclose the feature of "the one or more files examined comprises a history of one or more errors generated during the execution of the software system" (from amended claim 1, emphasis added). While the Examiner does not explicitly make such a contention, the Examiner does note "As per claims 3, 6 and 16, they recite limitations which have been addressed in claim 2 . . ."

Unfortunately, the Examiner's rejection of claim 2 does not appear to address where Chung is contended to recite that the one or more files examined comprises a history . . . generated during the execution of the software system. Thus, the Examiner has not adequately

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supported the anticipation rejection of amended claim 1, and the rejection is improper for at least this reason alone.

Furthermore, Applicant respectfully submits that Chung does not, in fact, disclose examining one or more files, where the one or more files examined comprises a history generated <u>during the execution</u> of the software system. Put simply, Chung does not consider errors actually generated during the execution of the software system. Rather, Chung considers errors detected by examining the source code of the software system.

Specifically, the errors on which Chung is focused are "internationalization errors." Chung discloses, at col. 5, lines 37-42:

> In step 202, the program may further scan the code counted in step 201 for internationalization errors and warnings. That is, the program may scan the code in a subset of source files stored in one or more subdirectories where each subdirectory corresponds to a component, i.e. element, of a software program.

The "code counted in step 201" referred to in the description of step 202 is "code in a subset of source files stored in the one or more subdirectories where each subdirectory corresponds to a component, i.e., element, of a software program." Col. 5, lines 22-25.

In other words, the code scanned for internationalization errors is source code contained in a "subset of source files" and is not a history generated <u>during the execution</u> of the software system. Neither is the table at col. 6, lines 12-25 a history generated <u>during the execution</u> of the software system. Rather, the table at col. 6, lines 12-25 is merely "illustrates the number of erros and warnings identified by the program for the code scanned in each component of a particular exemplary software component." Col. 6, lines 6-8.

Motivation for Combination is Hindsight

It is respectfully further submitted that the Examiner has not stated a proper motivation for combining Chung and Ruhlen. The motivation stated by the Examiner for combining the Chung and Ruhlen disclosures is that "the motivation for doing so would have been to minimize the time and cost of error processing . . ." In other words, the Examiner is contending essentially that the teachings of Ruhlen "would improve" the system of Chung by including "tracking and storing modification made in response to errors." Unfortunately, this stated motivation springs only from impermissible hindsight reasoning, and is not sufficient to support a prima facie case of obviousness.

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In particular, it is well settled that, for a proper prima facie case of obviousness, the prior art itself must suggest the desirability of the claimed subject matter. The Examiner is referred, for example, to MPEP 2143.01. There, it is discussed that the source of the motivation must be the cited references themselves or knowledge held by one of ordinary skill in the art. Furthermore, the Examiner is reminded that "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure." See MPEP 2143.

Here, the Examiner has pointed to nothing in the references or knowledge held by one of ordinary skill in the art that would suggest the alleged combinations of references. A bald, unsupported assertion that the teachings of a secondary reference "would improve" the teachings of a primary reference is insufficient. The Examiner has not pointed to anything in the references or knowledge held by one of ordinary skill in the art regarding the alleged improvement. Therefore, the Examiner must be relying on the impermissible hindsight gleaned from Applicant's disclosure, and the obviousness rejection is insufficient for this reason, too.

The Examiner has not provided a proper motivation to combine the references. Therefore, the rejection is unsupported by the cited references and should be withdrawn. If the Examiner maintains that the motivation for the cited combination is present in knowledge held by one of ordinary skill in the art, then Applicant respectfully requests the Examiner to provide evidence of such knowledge.

Conclusion

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
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